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**PATENT**

Customer No. 22,852  
Attorney Docket No. 05725.0800-00000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Roland BAZIN et al.

) Group Art Unit: 3743

Application No.: 09/725,048

) Examiner: Kathryn P. ODLAND

Filed: November 29, 2000

For: PROCESS FOR ACQUIRING SCANNED  
IMAGE DATA RELATING TO AN  
EXTERNAL BODY PORTION AND/OR A  
PRODUCT APPLIED THERETO

) Confirmation No.: 8605

**Mail Stop Appeal Brief--Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

This is an appeal to the Board of Patent Appeals and Interferences ("the Board") from the final Office Action dated July 28, 2004 ("Final Office Action"), finally rejecting claims 1 and 3-63, in the above-referenced patent application. Pursuant to 37 C.F.R. § 41.37, Appellant submits one copy of this Appeal Brief (37 C.F.R. § 41.37(a)(1)) accompanied by the fee (\$500.00) set forth in 37 C.F.R. § 41.20(b)(2).

A Notice of Appeal was filed on January 28, 2005, and, with the period for filing the Appeal Brief extending to June 28, 2005, by a Petition for a three-month extension of time and fee payment filed concurrently herewith, this Appeal Brief is being timely filed under 37 C.F.R. § 41.37.

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**I. Real Party in Interest**

The real party in interest is L'Oréal S.A., the assignee of the entire right, title, and interest in the application.

**II. Related Appeals and Interferences**

In U.S. Application No. 09/725,049 (attorney docket No. 05725.0784-00000), a Notice of Appeal was filed on March 14, 2005. (As of the filing date of this Appeal Brief, an appeal brief has not yet been filed in Application No. 09/725,049.) The appeal in U.S. Application No. 09/725,049 may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal. Appellant, Appellant's legal representatives, and assignee are aware of no other appeals, interferences, or judicial proceedings that may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

**III. Status of Claims**

Claims 1 and 3-63 are pending in this application. Claims 1 and 3-63, as set forth in the Claims Appendix, have been finally rejected in the Final Office Action and the rejections applied to those claims are at issue in this appeal.

#### **IV. Status of Amendments**

No amendments under 37 C.F.R. § 1.116 have been filed subsequent or in response to the Final Office Action. In a Response to Final Office Action and Request to Withdraw Its Finality, filed November 29, 2004, Applicant requested that the finality of the Final Office Action be withdrawn, but that request was denied in the Advisory Action dated December 13, 2004, based on the Examiner's completely unreasonable position that “[e]ven placing previously dependent claims into independent form changes the [claim] scope,” and based upon the Examiner’s allegation that listing claim 63 in new grounds of rejection was “accidental” and “merely a typographical error.” Advisory Action at 2.

## **V. Summary of Claimed Subject Matter**

### **A. Claims 1, 3, 21-23, 49-51, 53-58 and 60**

The subject matter set forth in claim 1 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. Page 4, lines 3-5.<sup>1</sup> The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. Page 4, lines 5-6. The transfer member may include adhesive material provided on a backing. Page 16, lines 18-19; Fig. 2. The adhesive material of the transfer member is placed in contact with skin while the adhesive material is on the backing and the transfer member is removed from the skin to transfer cells from the skin of the individual to the transfer member. Page 16, line 23 - page 17, line 3. The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14. The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. Page 4, lines 10-17; Figs. 3-9. The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9.

As set forth in claim 3, one aspect of the process further comprises placing the adhesive material of the transfer member in contact with adhesive material of a second

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<sup>1</sup> The references to the specification and drawings in this Brief are merely intended to facilitate explaining how the originally-filed application provides exemplary disclosure relating to the claimed subject matter. Those references are not necessarily exhaustive. Furthermore, those references should not be construed as limiting the claims.

transfer member and separating the transfer members to transfer a portion of the skin cells to the second transfer member. Page 17, lines 12-18.

In some aspects, as set forth in claims 21-23, the external portion of an individual includes at least one of the skin of the individual, at least one strand of hair of the individual, at least one fingernail of the individual, and at least one toe nail of the individual. Page 4, lines 10-13. In some such aspects, the external portion may be located on one of the hand, foot, arm, leg, torso, and face of the individual, as recited in claim 22. Page 4, lines 13-15. The external portion may be located on the lips of the individual, as recited in claim 23. Page 4, lines 13-15.

Other aspects are set forth in each of claims 49-51. In one aspect, the scanned image data includes data regarding color of the transfer image. Page 10, lines 7-9; page 15, lines 3-4; page 16, lines 3-5. In another aspect, the scanning includes emitting light from the scanner onto the transfer member, and the scanner may be configured in the form of a scanner for scanning documents. Page 10, lines 10-12; page 14, lines 18-21; page 15, lines 9-12.

Various other aspects are set forth in claims 53-56. One aspect further comprises obtaining scanned image data relating to multiple scanned images. Page 9, lines 1-5; page 10, lines 16-17. In other aspects, the transfer image on the transfer member indicates a condition of the external portion, and/or the transfer member is configured to change color in response to a condition of the external portion. Page 20, lines 1-5. And in another aspect, the process further comprises treating at least one of the transfer member and the external body portion to enhance the transfer image on the transfer member. Page 22, lines 3-14; Figs. 10a, 10b.

Other aspects are set forth in claims 57, 58 and 60. One aspect further comprises treating at least one of the transfer member and the external body portion, and removing the transfer member from the external body portion to transfer material to the transfer member, and wherein said treatment increases the amount of transferred material. Page 10, lines 20-22. Another aspect further comprises analyzing at least one of the external body portion and the transfer member with analysis equipment. Page 11, lines 1-3. And in another, the process further comprises analyzing the external portion by a trained person. Page 11, lines 1-3.

#### **B. Claims 4-10**

The subject matter set forth in claim 4 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. Page 4, lines 3-5. The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. Page 4, lines 5-6. The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14. The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. Page 4, lines 10-17; Figs. 3-9. The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9. The transfer member may be placed in contact with an external body portion including a cosmetic product applied thereto, and the image of the scanned image data

may be representative of at least one characteristic of the cosmetic product. Page 5, line 10 - page 6, line 4; page 17, line 19 - page 18, line 19; Fig. 7.

In one aspect, as set forth in claim 5, the external portion includes lips, and the cosmetic product is one of a lip care product and a lip makeup product. Page 5, lines 13-20; Page 17, line 22 - page 18, line 10; Fig. 7.

Claims 6-8 relate to the external portion including skin and the cosmetic product being foundation makeup. Page 5, line 21 - page 6, line 4; page 18, lines 12-19. In some aspects, the transfer member may be formed of fabric. Page 6, lines 1-4; page 18, lines 12-14. In one such aspect, the transfer member may be an article of clothing.

Id.

In other aspects, as set forth in claims 9 and 10, the transfer member may be a sheet of material, and the process may include placing the sheet of material in contact with lips of the individual and transferring a lip product from the lips to the sheet of material. Page 5, lines 13-20; page 17, line 22 - page 18, line 10; Fig. 7. In one such aspect, the lip product may be lipstick. Id.

### **C. Claims 11-20 and 24**

The subject matter set forth in claims 11-14 and 24 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. Page 4, lines 3-5. The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. Page 4, lines 5-6. The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14. The transfer image is not a fingerprint or

fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. Page 4, lines 10-17; Figs. 3-9. The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9.

In one aspect, as set forth in claim 11, the transfer member may be a moldable material, and the process may include placing the moldable material in contact with the skin of the individual to produce, on the moldable material, the surface profile of the skin. Page 6, lines 5-7; page 18, line 20 - page 19, line 1. For example, the moldable material could be scanned and used for the analysis of micro-reliefs in the skin. Page 19, lines 1-2.

In another aspect, as set forth in claim 12, the transfer member is a window that is a portion of the image scanner defining a scanning region. Page 6, line 21 - page 7, line 1; page 19, lines 3-17.

As recited in claim 13, the transfer member may be one of a hair comb and a hair brush. Page 6, lines 8-10. Placing the transfer member in contact with the external body portion may include passing the comb or the brush through the hair, and the transfer image may include strands of hair, skin cells or both. Page 6, lines 8-10.

In other various aspects, as set forth in claims 14-20, the process may further comprise placing the external portion of the individual in the vicinity of a scanning region of the image scanner, and scanning the external portion with the image scanner. Page 6, line 19 - page 7, line 7; page 19, lines 3-17. In one such aspect, the scanning of the

transfer image of the transfer member and the scanning of the external portion occur one of simultaneously and one after another. Page 19, lines 9-17. In other such aspects, as recited in claims 16-18, the external portion of the individual may be placed into contact with the scanning region of the scanner, and the external portion of the individual may be moved into contact with the scanning region of the scanner and/or a hand-held scanner may be moved into contact with the external portion. Page 20, lines 18-22; Fig. 8.

In another aspect, as recited in claim 19, the process may further comprise placing a liquid between the external body portion and the scanning region, the liquid altering the index of refraction to improve visualization of the at least one characteristic. Page 7, lines 3-7.

As recited in claim 20, the method may further comprise placing at least one of a dye and a pigment on the external portion to improve visualization of the at least one characteristic. Page 22, lines 13-14.

In another aspect, as set forth in claim 24, the external portion includes at least one strand of hair of the individual, and the at least one strand is one of a hair from the scalp, an eyelash, and an eyebrow. Page 4, lines 16 and 17.

#### **D. Claims 25-29**

The subject matter set forth in claim 25 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. Page 4, lines 3-5. The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. Page 4, lines 5-6. The transfer image is present on the

transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14. The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. Page 4, lines 10-17; Figs. 3-9. The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9. The image scanner may be associated with a first computer located at a first location. Page 7, lines 8-9. The process may further comprise transferring the scanned image data from the first computer to a second computer located at a second location remote from the first location. Page 7, lines 8-11.

In various aspects, as set forth in claims 26 and 27, transferring the scanned image may include transmitting the scanned image data via the internet, and/or storing the data on a data storage medium and shipping the data storage medium. Page 7, lines 11-13.

In other various aspects, as set forth in claims 28 and 29, questionnaire answers, and/or billing payment information may be transferred. Page 7, lines 14-18.

#### **E. Claims 30-36**

The subject matter set forth in claim 30 relates to a process of analyzing at least one characteristic of an external body portion of an individual and/or at least one product applied to the external body portion. Page 7, lines 18-20. The process comprises acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, displaying an image corresponding to the

scanned image data, and viewing the displayed image to analyze the at least one characteristic. Page 7, lines 19-21.

In one aspect, as set forth in claim 31, the image is displayed at the second location. Page 8, lines 20-22. In another aspect, as set forth in claim 32, the image is sent to a plurality of locations so that the at least one characteristic may be analyzed numerous times. Page 8, lines 20-22.

In other various aspects, as set forth in claims 33-36, the method may include monitoring a status of the external portion during treatment of the external portion (e.g., repeating at least the acquiring of the scanned image data), providing a recommendation for a treatment of the external portion based on the monitored status, and/or providing the individual with information regarding the effectiveness of the treatment. Page 9, lines 1-5.

#### **F. Claim 37**

The subject matter set forth in claim 37 relates to a process of analyzing at least one characteristic of an external body portion of an individual and/or at least one product applied to the external body portion. Page 7, lines 18-20. The process may comprise analyzing at least one characteristic of an external body portion acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, displaying an image corresponding to the scanned image data, viewing the displayed image to analyze the at least one characteristic, and comparing the displayed image to at least one image formed from image data stored in an image database. Page 7, lines 19-21; page 10, lines 4-6.

Acquiring scanned image data comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. Page 4, lines 5-6. The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14. The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. Page 4, lines 10-17; Figs. 3-9. The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9.

#### **G. Claims 38-45**

The subject matter set forth in claim 38 relates to a process for recommending treatment for an external body portion of an individual and/or at least one product applied to the external body portion. Page 9, lines 6-7. The process may comprise analyzing at least one characteristic of an external body portion, determining a recommendation of at least one treatment for the external portion, and providing the treatment recommendation so that the external portions of the individual may be treated according to the recommendation. Page 9, lines 6-11

The analyzing may comprise, acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, displaying an image corresponding to the scanned image data, and viewing the displayed image to analyze the at least one characteristic. Page 7, lines 19-21.

Acquiring scanned image data comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. Page 4, lines 5-6. The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14. The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. Page 4, lines 10-17; Figs. 3-9. The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9.

In one aspect, as set forth in claim 45, a computer may at least partially perform the determining of the treatment recommendation, the computer being located at a location remote from that of the image scanner. Page 9, lines 9-11.

In some various aspects, as set forth in claims 39-41, the treatment recommendation may be a recommendation regarding use of at least one of a cosmetic product and a dermatological product. Page 9, lines 12-14. In one aspect, at least one of the products may be one of a makeup product, a care product, a hair product, a skin product, and a sun exposure product. Page 9, lines 12-14. In another aspect, the treatment recommendation may be a recommendation regarding application of the product to the external portion. Page 9, lines 14-16.

In another aspect, as set forth in claim 42, the process may further comprise providing product ordering information along with the treatment recommendation. Page 9, lines 15-16.

In other various aspects, as set forth in claims 43 and 44, the providing of the treatment recommendation may include providing the treatment recommendation to at least one of the individual and a treatment provider. Page 9, lines 17-19. In one aspect, the recommendation is transmitted to the individual and/or treatment provider via the internet. Page 9, lines 17-19.

#### **H. Claims 46 and 47**

The subject matter set forth in claim 46 relates to a process of evaluating a product applied to an external body portion. Page 9, lines 20-22. The process may comprise analyzing at least one characteristic of a product applied to an external body portion. Page 10, lines 4-6. The analyzing may comprise, acquiring scanned image data, displaying an image corresponding to the scanned image data, and viewing the displayed image to analyze at least one characteristic. Page 7, lines 19-21.

Acquiring scanned image data comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. Page 4, lines 5-6. The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14. The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. Page 4, lines 10-17; Figs. 3-9. Acquiring scanned image date further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9.

As set forth in claim 47, the transfer member may be placed in contact with an external body portion including a cosmetic product applied thereto. Page 5, lines 10-13. The scanned image date may be representative of at least one characteristic of the cosmetic product. Page 5, lines 10-13.

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#### **I. Claims 48, 52, 59 and 61-63**

The subject matter set forth in claims 48, 52, 59, 61 and 63 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. Page 4, lines 3-5. The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. Page 4, lines 5-6. The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. Page 5, lines 1-14. The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. Page 4, lines 10-17; Figs. 3-9. The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. Page 4, lines 7-9.

As set forth in claim 48, the process may comprise collecting information relating to the transfer image of the transfer member to form a database for use in at least one of diagnoses, treatment recommendation determinations, product evaluations, and product formulations. Page 10, lines 1-4.

As set forth in claim 52, the process may comprise scanning, with the image scanner, a calibration member having one of a predetermined size and a predetermined color. Page 4, lines 7-9; page 10, lines 13-15. For example, the transfer image may be scanned along with the calibration member to provide a more exact indication of the size and/or color of characteristics. Page 10, lines 13-15; Page 24, lines 5-9.

As set forth in claim 59, the process may comprise analyzing at least one of the external body portion and the transfer member with analysis equipment chosen from one of a corneometer, a dermal torque meter, an image analyzer, a PH meter, and a device for measuring hydration of the skin. Page 25, lines 5-9.

As set forth in claims 61 and 62, the process may further comprise providing a grade indicative of at least one of the condition of the external portion and performance of the product. Page 11, lines 4-9; page 25, lines 11-15. As recited in claim 62, information relating to the grade may be stored in a database. Page 11, lines 4-9; page 25, lines 11-15.

As set forth in claim 63, the scanner may be configured in the form of a scanner for scanning documents. Page 14, line 19-21.

## VI. Grounds of Rejection to be Reviewed on Appeal

Claim 11 stands rejected under “35 U.S.C. 102(a and/or e)” as being anticipated by U.S. Patent No. 6,533,971 to Stess et al. (“Stess”).

Claims 52 and 53 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,343,536 to Groh (“Groh”).

Claims 1, 21, 22, 49, 50, 58 and 60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Groh in view of JP 407274996 to Kawashima et al. (“Kawashima”).

Claims 12, 14-16, 25-32, 52 and 63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,178,255 to Scott et al. (“Scott”) in view of U.S. Patent No. 6,355,439 to Chung et al. (“Chung”).

Claims 1, 11-40, 43-46, 49-59 and 63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,241,668 to Herzog (“Herzog”) in view of FR 2736450 to Dusserre (“Dusserre”) and further in view of Groh and further in view of Kawashima.<sup>2</sup>

Claims 1, 3-10, 12, 14-16, 18, 38-43, 46-50 and 60-63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,785,960 to Rigg et al. (“Rigg”) in view of Dusserre and further in view of Groh and further in view of Kawashima.<sup>3</sup>

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2 The Advisory Action at 2 indicates that the “accidental listing in the new ground of rejection was merely a typographical error.” Based on that comment, Appellants believe claim 63 may only be rejected in the Section 103(a) rejection based on Scott in view of Chung. Appellants request that the Examiner clarify this issue in the Examiner’s Answer.

3 See supra footnote 2.

## VII. Argument

### A. Rejections under 35 U.S.C. § 102

#### 1. Legal standard under 35 U.S.C. § 102

In order for a claim to be anticipated by a prior art reference under 35 U.S.C. § 102, each and every element in the claim must be found, either expressly or inherently, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); and the identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1929 (Fed. Cir. 1989). See also M.P.E.P. § 2131. As discussed below, each of the rejections under 35 U.S.C. § 102 should be reversed because each and every element recited in the claims is not disclosed by the cited references.

#### 2. Rejection of claim 11 under “35 U.S.C. 102(a and/or e)” based on Stess should be reversed.

##### a. Disclosure of Stess

Stess discloses a method of forming a custom molded orthopedic impression shirt, wherein the method includes first mounting a release shirt or layer on a patient's torso and then mounting a resin-impregnated impression shirt over substantially the entire release shirt. Col. 2, lines 20-31. The resin of the impression shirt is allowed to harden and then the hardened impression shirt is removed from the torso. Col. 2, lines 31-34. Stess further discloses using a digital scanner 51 to scan the outside or inside of the hardened impression shirt so that an orthosis may be formed. Col. 6, lines 3-27.

- b. **Stess lacks any teaching of “scanning . . . with an optical image scanner to obtain scanned image data for an image”**

Stess does not disclose or suggest “scanning . . . with an optical image scanner to obtain scanned image data for an image,” as set forth in claim 11. Based on the Examiner’s comments, the Examiner seems to be equating Stess’s general disclosure of a digital scanner 51 with an “optical image scanner.” E.g. Final Office Action, pg. 7. Stess merely discloses using a digital scanner to obtain “digital data” relating to the dimensions of the impression shirt. Col. 6, lines 10-31. There is nothing in Stess providing any express or inherent teaching of the recited “scanning . . . with an optical image scanner to obtain scanned image data for an image.” Stess never mentions or suggests an “optical image” or “scanned image data for an image.” Indeed, Stess’s digital scanner is not described as being an “optical image scanner.” Furthermore, there are many digital scanners that are not optical image scanners (i.e., some scanners using technology without any optical imaging).

Since the purpose of Stess’s disclosed digital scanner 51 relates to proper dimensioning of an orthosis, one of ordinary skill in the art would understand that Stess’s scanner 51 would merely obtain dimensions of the impression shirt rather than obtaining any “image data” for an “image.” Accordingly, the § 102 (a and/or e) rejection should be reversed.

- c. **Stess lacks any teaching of “placing the moldable material in contact with the skin of the individual to produce, on the moldable material, the surface profile of the skin”**

Stess does not disclose or suggest “placing the moldable material in contact with the skin of the individual to produce, on the moldable material, the surface profile of the

skin," as recited in claim 11. Contrary to the Examiner's assertion, Stess's disclosure of mounting an impression shirt over a release shirt without contacting the impression shirt with skin cannot be equated with the subject matter recited in claim 11.

First, Stess's impression shirt is not moldable. Even though Stess mentions applying the impression shirt layer 27 over the release shirt layer 23 and insulating layer 25, and bonding the impression shirt 27 to one other layer, such disclosure does not provide any teaching of placing moldable material in contact with skin because the bonding of layers 25 and 27 occurs only after the impression shirt 27 hardens and thus becomes non-moldable. Col. 5, lines 58-66.

Second, and more importantly, Stess does not disclose or suggest the impression shirt material itself contacting skin. Col. 5, lines 36-41. In fact, Stess describes in detail the necessity of a thermal insulation layer and how to prevent skin from contacting the impression shirt material. E.g. col. 3, lines 29-40; col. 3, lines 58-67; col. 4, lines 54-67. Thus, not only does Stess fail to teach placing a moldable material in contact with skin, the reference actually teaches away from any such contact.

For at least these reasons, the rejection of claim 11 based on Stess should be reversed.

**3. Rejection of claims 52 and 53 under 35 U.S.C. § 102(b) based on Groh should be reversed**

**a. Disclosure of Groh**

Groh discloses a method involving the steps of applying an adhesive 12, preferably cyanoacrylate (e.g., Super Glue), to the skin 15, placing a slide 11 in contact with the adhesive 12 until the skin 15 adheres to the slide 11, and then peeling the slide 11 away from the surrounding skin 15 while an attached skin specimen 16 is adhered to

the slide 11. Col. 4, lines 1-19; Figs. 1-5. Thereafter, the slide is evaluated under a stereoscopic microscope under cross-polarized light, and then an image of the slide is captured and analyzed using image analysis hardware and software. Col. 4, lines 20-49; fig. 6. Groh also discloses filtering out background lighting and noise and assigning grey levels to different portions of the image to identify features of interest. Col. 5, lines 8-32; col. 6, lines 7-59.

- b. **Groh lacks any teaching of “scanning . . . a calibration member having one of a predetermined size and a predetermined color”**

Groh does not disclose “scanning . . . a calibration member having one of a predetermined size and a predetermined color,” as recited in claim 52. Although Groh refers to filtering out background light and noise, Groh does not disclose scanning a calibration member having a predetermined size and/or, color. Groh’s disclosed filtering process changes the image to fit a desired range of grey-scale, without a calibration member that is scanned with an image scanner. Col. 5, lines 8-32; col. 6, lines 7-59. The mere disclosure of the use of software in connection with assigning grey levels does not teach “scanning . . . a calibration member.”

Regarding the § 102(b) rejection of claim 53, claim 53 depends from claim 1 and should therefore be allowable over Groh for at least the same reasons claim 1 is allowable over that reference (i.e., Groh has no disclosure of the subject matter of claim 1). Since there is no § 102(b) rejection of claim 1 as anticipated by Groh, the rejection of dependent claim 53 should be reversed.

For at least the reasons discussed above, the § 102(b) rejection of claims 52 and 53 should be reversed.

## **B. Rejections under 35 U.S.C. § 103**

As a preliminary matter, in each of the § 103(a) rejections, the Examiner makes several unsupported conclusory allegations regarding the Examiner's hypothetical combinations of references. As discussed more fully below, "broad conclusory statements standing alone are not 'evidence'." In re Kotzab, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). Several of the Examiner's unsupported conclusory statements are addressed in the following discussion.

### **1. Requirements for *prima facie* obviousness**

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in Graham v. John Deere Co., 383 U.S. 1, 17 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or nonobviousness of the claimed invention is then evaluated in view of the results of these inquiries. Id. at 17-18. In making this evaluation, the references must be considered as a whole, and must suggest the desirability and thus the obviousness of making the combination. See M.P.E.P. § 2141. The references must also be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. Id. Additionally, a reasonable expectation of success is the standard with which obviousness is determined. Id. Furthermore, the Examiner bears

the initial burden of factually supporting a determination of obviousness in the rejection of the claimed invention. See M.P.E.P. § 2142.

Thus, in order to carry the initial burden of establishing a *prima facie* case of obviousness that satisfies the Graham standard, the Examiner must satisfy three basic criteria. First, the prior art references when combined must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Further, the Federal Circuit has emphasized the high burden for establishing a *prima facie* case of obviousness and the requirement for specificity in the evidence necessary to support a *prima facie* case. For example, in In re Kotzab, the Federal Circuit held that “[e]ven where obviousness is based on a single prior art reference teaching all of the individual elements of the claims, there must be a showing of a suggestion or motivation to modify the teachings of that reference. 217 F.3d at 1370, 55 U.S.P.Q.2d at 1317. Whether this showing is based on an implicit or express showing in the reference, the Examiner “must provide particular findings related thereto.” Id. (citing In re Dembiczkak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (requiring a “clear and particular” suggestion to combine or modify prior art references). References that teach away from a combination may not be used to establish obviousness. Tec Air, Inc. v. Denso Mfg. Michigan, Inc., 192 F.3d 1353, 1360, 52 U.S.P.Q.2d 1295, 1298 (Fed. Cir. 1999). In re Kotzab also reiterates the proposition that “broad conclusory statements standing alone are not ‘evidence’.” Id.

Additionally, in In re Lee, the Federal Circuit held that “[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” 277 F.3d 1338, 1342, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002).—Further, it is “never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection is based.” See M.P.E.P. § 2144.03.E; See In re Zurko, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001); In re Ahlert, 424 F.2d 1088, 1092, 165 U.S.P.Q. 418, 421 (C.C.P.A. 1970).

Also, simply because references can be modified or combined is not sufficient basis to establish a *prima facie* case of obvious. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. And even if the claimed limitations are within the capabilities of one skilled in the art, such capabilities, by themselves, are not sufficient to establish a *prima facie* case of obviousness. In re Kotzab, 217 F.3d at 1370, 55 U.S.P.Q.2d at 1318; M.P.E.P. § 2143.01.

For the reasons set forth below, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness in each of the § 103 rejections.

2. **Rejection of claims 1, 21, 22, 49, 50, 58 and 60 under 35 U.S.C. § 103(a) based on Groh and Kawashima should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness**

a. **The rejection based on Groh and Kawashima does not set forth a *prima facie* case of obviousness because there is no motivation to combine the references**

As discussed above, in order to carry the initial burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must show that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. § 2143.

Whether this showing is based on an implicit or express showing in the reference, the Examiner "must provide particular findings related thereto." Id. (citing In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (requiring a "clear and particular" suggestion to combine or modify prior art references). Moreover, "broad conclusory statements standing alone are not 'evidence'." Id.

In the Final Office Action dated July 28, 2004, the Examiner states:

"Groh does not recite a transfer member having an adhesive material provided on a backing where the adhesive material of the transfer member is placed in contact with the skin while the adhesive is on the backing . . . Kawashima et al. disclose tacky tape as a transfer member for observing skin through a scanner."

Final Office Action at 9.

Neither Groh nor Kawashima provides any suggestion or motivation to modify or combine the references as asserted by the Examiner. The Examiner correctly assesses that Groh does not disclose a "transfer member [that] includes adhesive material on a backing, the adhesive material of the transfer member being placed in contact with skin

while the adhesive member is on the backing and the transfer member being removed from the skin to transfer cells from the skin of the individual to the transfer member," as required by claim 1. The Examiner attempts to supply this deficiency by pointing to Kawashima.

As an initial matter, the Examiner misstates the teachings of Kawashima. Rather than having any teaching of "tacky tape as a transfer member for observing skin through a scanner," the English language abstract of Kawashima does not have any mention of a scanner. The abstract does mention a scanning electron microscope ("SEM"), but even though an SEM contains the word "scanning" in its name, an SEM is not an optical image scanner. An SEM is defined as

"an electron microscope that forms a three-dimensional image on a cathode-ray tube by moving a beam of focused electrons across an object and reading both the electrons scattered by the object and the secondary electrons produced by it."

THE AMERICAN HERITAGE COLLEGE DICTIONARY (4th ed. 2002), p. 1238. Rather than conducting optical image scanning, SEMs "read" electrons. Additionally, SEMs require a conductive surface on the specimen to allow electrons to bounce off of the surface.<sup>4</sup> As a result, Kawashima also requires that ". . . gold is deposited on a tacky tap[e] to which the keratin layer is stuck and the deposited tacky tape is observed by a scanning electron microscope." Abstract.

Accordingly, the Examiner appears to have misconstrued the teachings of Kawashima, and nothing in the Office Action provides any support for the assertion that Kawashima discloses a scanner.

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<sup>4</sup> See, i.e. <http://mse.iastate.edu/microscopy/sputtering.html>. ("The sputter coater is used to coat non-metallic samples (bugs, plants, human hair, etc.) with a thin layer of gold. This makes them conductive, and ready to be viewed by the SEM.")

Groh and Kawashima are dissimilar references that cannot be combined to render obvious the invention of claim 1. Groh relates to a method for evaluating comedones on the skin through the use of follicular biopsy slides and image analysis. Col. 1, lines 7-9. Kawashima, on the other hand, concerns a method for observing fungus existing on a keratin layer of skin by the use of a microscope or SEM. While Kawashima does mention a tacky tape used with an SEM, the tacky tape of Kawashima apparently includes gold to be deposited on the keratin layer to allow the SEM to view the fungus and keratin. Certainly, one of ordinary skill would not look to layering comedones with gold prior to scanning them with an optical image scanner.

The Examiner has not set forth a *prima facie* case of obviousness because there is no plausible reason why one of ordinary skill in the art would have looked to Kawashima's disclosure dealing with fungus and gold layering for SEM observation, in order to modify Groh's dissimilar subject matter relating to evaluation of comedones on the skin.

Moreover, one of ordinary skill in the art would not have had any reason to use anything other than the non-adhesive glass slide 11 disclosed in Groh because Groh specifically teaches that “[t]he material of the microscopic slide 11 is preferably a material that is non-reactive to cyanoacrylate, and is most preferably glass as glass slides tend to be more durable than thinner, film slides.” Col. 4, lines 10-14. The English abstract of Kawashima does not have any mention of the “tacky tape” being non-reactive to cyanoacrylate. In addition, since “tape” is generally made of thin, flexible, non-glass material, Kawashima's “tacky tape” would more than likely not be made of glass or more durable than thin film slides, as required by Groh at col. 4,

lines 10-14. Thus, Groh teaches away from the hypothetical combination proposed by the Examiner and establishes that there is no *prima facie* case of obviousness. See Tec Air, 192 F.3d at 1360, 52 U.S.P.Q.2d at 1298.

Because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, the § 103(a) rejection of independent claim 1 based on Groh and Kawashima should be reversed.

**b. The rejection based on Groh and Kawashima does not set forth a *prima facie* case of obviousness because there is no reasonable expectation of success**

In order to carry the initial burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must show that there is a reasonable expectation of success. See M.P.E.P. § 2143.

As discussed above, Groh's method essentially entails gluing a glass slide to a person with cyanoacrylate (e.g., Super Glue) and then peeling the slide off of the person with a layer of skin including comedones adhered to the slide. Col. 4, lines 1-14; Figs. 3, 4. Even if Kawashima's "tacky tape" could be used in Groh's method, it would more than likely not remove a sufficient amount of skin and comedones for Groh's method. For example, since Kawashima's abstract does not refer to removing skin when pulling the "tacky tape" from a person, the tacky tape more than likely would not have a strong adhesive such as cyanoacrylate. Thus, there is no reasonable expectation of success in using Kawashima's "tacky tape" in place of the cyanoacrylate and glass slide of Groh. For at least this additional reason, the final Office Action fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Dependent claims 21, 22, 49, 50, 58 and 60 each depend from independent claim 1 and, therefore, include all the recitations of claim 1. As discussed above, there is no suggestion or motivation to combine, or any reasonable expectation of success in combining Groh and Kawashima as proposed by the Examiner. Because claim 1 is allowable, each of the dependent claims is allowable at least due to its dependency from claim 1. As such, the § 103(a) rejection of dependent claims 21, 22, 49, 50, 58 and 60 based on Groh and Kawashima should be reversed.

**3. Rejection of claims 12, 14-16, 25-32, 52 and 63 under 35 U.S.C. § 103(a) based on Scott and Chung should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness**

**a. Disclosure of Scott and Chung**

Scott discloses an automatic fingerprinting device which creates digital fingerprint images by directly scanning a finger or fingers placed on platen 72. Col. 4, lines 39-67. Chung discloses a method for obtaining human DNA for genetic analysis by using an adhesive sheet. Col. 5, line 56 - col. 6, line 43. The adhesive sheet also captures fingerprints, handprints and footprints. Col. 6, lines 8-14. In addition, both the identification and the DNA analysis of a testee can be stored electronically by creating an electronic file of the DNA analysis and the fingerprints, handprints and footprints. Col. 6, lines 25-42.

**b. The rejection based on Scott and Chung does not set forth a *prima facie* case of obviousness because the references fail to disclose or suggest every element**

As previously discussed, the prior art references when combined must teach or suggest all the claim elements. See M.P.E.P. § 2143. Neither Scott nor Chung, either

alone or in combination, discloses or suggests “scanning [a] transfer image,” as recited in claims 12, 14, 25, 52, and 63.

In the Final Office Action, the Examiner asserts “fingerprints will remain on the platen 72 [of Scott] and applicant clearly discloses that as a possible transfer member . . .” Final Office Action at 5. The Examiner also asserts that, “Chung et al. teach adhesive sheets to obtain samples and to record the image on an electronic medium” and that “it would be further obvious to also include adhesives as transfer members in addition to the image scanner plate . . . for the purpose of enabling the capture of additional information.” Final Office Action at 11.

The Examiner fails to appreciate the fact that Scott has no disclosure of “scanning (a) transfer image” on a transfer member, as recited in claims 12, 14, 25, 52, and 63. Contrary to the Examiner’s assertion, there is no significance relating to the mere possibility that one or more fingerprint impressions might remain after touching Scott’s platen 72. Even if a fingerprint impression might remain on Scott’s platen 72 after it is touched, there is no disclosure of scanning that fingerprint impression. Rather than scanning a print impression left by a finger, Scott discloses directly scanning one or more fingers alone, not a fingerprint impression, to acquire an optical image of the actual fingers not an optical image of a fingerprint impression. See col. 2, lines 8-10; col. 4, line 39 - col. 5, line 6. Accordingly, Scott has no disclosure or suggestion of the claimed “scanning [a] transfer image.”

Although Chung discloses creating digital images through scanning, Chung does not disclose “scanning [a] transfer image.” Col. 6, lines 25-42. Chung merely describes scanning a photograph or taking direct digital images of hands to obtain digital images

of fingerprints or palm prints without having any disclosure of scanning a transfer image. A photograph does not correspond with a transfer member according to claims 12, 14, 25, 52, and 63 because a photograph is not placed “in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,” as recited in the claims. Furthermore, taking direct digital images of a hand, as disclosed in Chung, also does not involve scanning a transfer image on a transfer member. Thus, neither Scott nor Chung discloses or suggests “scanning [a] transfer image” as claimed.

Additionally, regarding independent claim 63, Scott and Chung fail to disclose or suggest a “scanner configured in the form of a scanner for scanning documents.” Consequently, the section 103(a) rejection of claim 63 should be reversed for that additional reason.

Also, the references have no disclosure or suggestion of scanning a calibration member, as recited in claim 52.

Thus, at least for the reasons discussed above, the Examiner failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) because Scott and Chung, either alone or in combination, fail to disclose each claimed element.

- c. **The rejection based on Scott and Chung does not set forth a *prima facie* case of obviousness because there is no motivation to combine the references**

As discussed above, in order to carry the initial burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must show that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. § 2143.

The Examiner has not established a *prima facie* case of obviousness because there is no suggestion or motivation for using Scott's fingerprint scanner for scanning anything other than fingerprints. Each of the claims requires that "the transfer image is not a fingerprint or fingerprints."

— The Examiner alleged that "it is well known to expand fingerprinting to include other body parts such as toes." Final Office Action at 4. appellants disagree with the Examiner's allegation of "well known" subject matter. Contrary to the Examiner's unsupported assertion, the term "fingerprinting," by definition, relates to the fingers, not toes or other body parts. Furthermore, the mere mention of taking fingerprints and toeprints in "My Sweet Baby Zachary" by Susan Holstine ( an "internet blog" cited in the Final Office Action at 4) does not provide any suggestion for fingerprinting to include toeprinting, and more importantly, does not suggest using a fingerprint scanner to take prints of toes or other body parts. In fact, since the Susan Holstine "internet blog" refers to both fingerprinting and toeprinting, it is clear that they are different from one another and that fingerprinting would not encompass taking prints of body parts other than the fingers. Further, even if there might have been situations where fingerprints and toeprints of new-born babies have been taken, there would have been no suggestion or motivation for using a scanner to take such prints, and there clearly would have been nothing to suggest using Scott's finger scanner to scan toes since toe prints are not used by governmental agencies to identify individuals. See, e.g., Scott at col. 2, lines 10-12.

There is simply no reason why one of ordinary skill in the art would have been motivated to use Scott's fingerprint scanner for scanning anything other than

fingerprints. Independent claims 12, 14, 25, 52, and 63 recite a “transfer image [that] is not a fingerprint or fingerprints.” Therefore, those claims are patentably distinguishable from the subject matter of Scott.

Furthermore, nothing supports the Examiner’s assertion that “it would be obvious to expand the system to include other body parts such as toe prints for the purpose of obtaining and database storing data of scanned image.” Final Office Action at 11. Chung concerns a method of obtaining DNA samples. The disclosure of Chung does not provide any motivation or suggestion for using a fingerprint scanner, such as that of Scott, in any manner other than for scanning fingers. In particular, Chung does not provide anything supporting the Examiner’s assertion that it would have allegedly been obvious to use Scott’s fingerprint scanner to scan “other body parts.” There is simply no reason why one of ordinary skill in the art would have had any motivation to modify Scott’s fingerprint scanner to include any of Chung’s subject matter relating to DNA sampling.

Because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, the § 103(a) rejection based on Scott and Chung should be reversed.

Dependent claims 15, 16 and 26-32 each depend from one of independent claims 14 and 25 and, therefore, include all the recitations of the corresponding independent claim from which they depend. Accordingly, the Section 103(a) rejection of those dependent claims should be reversed.

For at least these reasons, the § 103 claim rejection relying on Scott and Chung should be reversed.

**4. Rejection of claims 1, 11-40, 43-46, 49-59 and 63 under 35 U.S.C. § 103(a) based on Herzog, Dusserre, Groh, and Kawashima should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness**

**a. Disclosure of Herzog, Dusserre, Groh, and Kawashima**

Groh and Kawashima are discussed in detail above in sections VII. A(3) and B(2).<sup>5</sup> Herzog discloses a medical information system contemplating various means of data input. For example, Herzog indicates that

a pass photo for identification of the patient can be generated by the digital photo camera 14, and medically relevant optical images can be generated.... [M]edically relevant optical images can be acquired by means of the video camera.... Additional documents, reports, graphics and/or films relevant to the diagnosis can be scanned in . . . via a scanner 16, for example.

Col. 3, lines 12-40.

Dusserre discloses a network that allows multiple persons in different locations to view images, in real time or at their discretion. This allows medical professionals to obtain medical opinions from various sources. Page 2 (English translation).

In addition to citing the four references mentioned in the rejection, the Examiner cites two additional references, Rose, "MU unveils pilot program for distance plant diagnosis" ("Rose") and La Rosa, "High Resolution and Low Cost Static Telepathology" ("La Rosa"). Final Office Action at 5. Rose relates to the art of identifying insects and

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5 To the extent that the rejection of claims 1, 11-40, 43-46, 49-59, and 63 involves issues in common with those discussed in Section VII.B(2) (e.g., issues relating to Groh and/or Kawashima), Appellants corresponding remarks of Section VII.B(2) are incorporated in this section of the Brief.

plants such as weeds using photography, including digital photography. As discussed below, La Rosa generally mentions scanning histological slides, but has no indication of how such slides are prepared prior to scanning.

- b. **The rejection based on Herzog, Dusserre, Groh, and Kawashima does not set forth a *prima facie* case of obviousness because the references fail to disclose or suggest every element**

As previously discussed, the prior art references when combined must teach or suggest all the claim elements. See M.P.E.P. § 2143. None of Herzog, Dusserre, Groh, and Kawashima, either alone or in combination, discloses or suggests “scanning [a] transfer image with an optical image scanner,” as recited in each of the rejected independent claims.

In the Final Office Action, the Examiner alleges that Herzog “discloses . . . placing a transfer member in contact with an external portion of an individual . . . and scanning the transfer image” and that “it is within the scope of [Herzog’s purported] invention to use the scanner for obtaining human scanning information.” Final Office Action at 11. Herzog’s mere disclosure of a “scanner 16” used to scan “additional documents, reports, graphics and/or films” (col. 3, lines 32-34) does not provide any teaching or suggestion of the claimed subject matter.

Despite Applicants’ repeated requests<sup>6</sup>, the Examiner has not explained the basis for these unsupported allegations. In addition, the Examiner has provided absolutely nothing to support her allegations of obviousness regarding the use of “transfer members in the system of Herzog.”

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<sup>6</sup> See e.g. Response to Office Action Dated July 15, 2003 at 5 (Jan. 14, 2004).

The Examiner has apparently acknowledged that Herzog's only disclosure relating to scanning concerns placing documents on a scanner. Nonetheless she has alleged that "it is within the scope of the invention to use the scanner for obtaining human scanning information." Final Office Action at 11-12. Documents that are scanned cannot be equated with transfer images on a transfer member because they are not necessarily placed "in contact with an external portion of an individual so as to obtain a transfer image on the transfer member . . . wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another." In addition, the Examiner's apparent attempt to equate the window on Herzog's scanner with a transfer member (Final Office Action at 12) is misplaced because Herzog simply fails to disclose or suggest scanning any transfer image on that window.

In addition to referring to Herzog's scanner 16 that is used to scan documents, the Final Office Action also cites reference numerals 1, 2, 3, and 4 of Herzog, which are CT, MR, DSA, and x-ray equipment, respectively, not optical image scanners. Pg. 11. The Examiner has failed to explain how these various pieces of equipment allegedly disclose or suggest "scanning [a] transfer image." The Examiner alleges that Dusserre "teaches transferring human data via scanning, as recited on page 4 and throughout the specification." Final office Action at 12. Such an allegation lacks any support. On close inspection of Dusserre, that reference only mentions a scanner on one occasion, (Dusserre at 4 (English translation).) without disclosing how that scanner is used.

The mere mention of a scanner in Herzog and Dusserre does not provide any disclosure of "scanning [a] transfer image," as claimed. Even though the methods set

forth in the claims could be practiced by using conventional documents scanners, as well as other optical image scanners, the cited references fail to disclose using any such optical image scanner as claimed.

Rose and La Rosa also fail to disclose or suggest “scanning [a] transfer image with an optical image scanner,” and do not overcome the deficiencies of the hypothetical combination of Herzog, Dusserre, Groh, and Kawashima, which fails to establish *prima facie* obviousness.

Rose and La Rosa do not provide any suggestion or motivation to modify the other cited references in a manner that would suggest the claimed subject matter. Rather than relating to the field of acquiring scanned image data relating to an external body portion and/or a product applied to a body portion, Rose relates to the non-analogous art of identifying insects and plants such as weeds. Further, contrary to providing any suggestion to use Herzog’s scanner, as apparently proposed by the Examiner, Rose in its concluding paragraph touts the “big advantage” of using a digital camera in place of a scanner because a digital camera is portable and also able to accommodate large mushrooms. Thus, Rose teaches away from the Examiner’s hypothetical proposal to use a scanner.

Turning briefly to La Rosa, even though that reference mentions a pathological technique involving a scanner used to scan histological glass slides, nothing in that reference provides any suggestion of using Herzog’s scanner 16 to scan anything other than “additional documents, reports, graphics and/or films,” as described in Herzog at col. 3, lines 32-34. La Rosa also does not have any teaching or suggestion of scanning an image of a transfer member that has been obtained by placing the transfer member

in contact with an external body portion, as recited in the rejected claims. For example, since there is nothing more than a general mention of La Rosa's histological glass slides, there is no teaching of placing those slides in contact with an external body portion.

Additionally, Herzog, Dusserre, Groh, and Kawashima do not provide any teaching or suggestion of "moldable material," as recited in claim 11; scanning a transfer image of a "transfer member [that] is a window" as recited in claim 12; a "transfer member [that] is one of a hair comb and a hair brush," as recited in claim 13; a "hand-held scanner . . . moved into contact with the external portion of the individual," as recited in claim 18; "placing liquid between the external body portion and the scanning region," as recited in claim 19; "wherein the external portion is located on the lips," as recited in claim 23; "wherein the external portion includes at least one strand of hair of the individual," as recited in claim 24; "transferring questionnaire answers . . . related to a condition of the external portion [or] the product applied to the external portion," as recited by claim 28; "sending . . . at least one of billing information and payment information," as recited in claim 29; "comparing the displayed image to at least one image formed from image data stored in an image database," as recited in claim 37; "determining a recommendation," as recited in claim 38; "a treatment recommendation of a . . . cosmetic product [or] a dermatological product," as recited in claim 39; "analyzing at least one characteristic of a product," as recited in claim 46; a "calibration member," as recited in claim 52; or "analysis equipment [that] is chosen from . . .," as recited in claim 59.

For each of those recitations, the Examiner either completely failed to address the claim limitation, or simply made an unsupported conclusory allegation lacking any evidentiary support. See Final Office Action at 11-14. Those unsupported and conclusory allegations simply do not provide a proper foundation for a *prima facie* case of obviousness.

Thus, at least for the reasons discussed above, the Examiner failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) because Herzog, Dusserre, Groh, and Kawashima, either alone or in combination, fail to disclose or suggest each claimed element.

**c. The rejection based on Herzog, Dusserre, Groh, and Kawashima does not set forth a *prima facie* case of obviousness because there is no motivation to combine the references**

Contrary to the Examiner's apparent assertions, Duesserre, Groh, and Kawashima do not provide any suggestion or motivation to use Herzog's scanner 16 for anything other than scanning "additional documents, reports, graphics and/or films." Col. 3, lines 32-34. Appellants disagree with the Examiner's allegations about subject matter that is allegedly "well known" and/or the subject of "thousands of patents and applications" and submit that such allegations are simply insufficient to establish a *prima facie* case of obviousness. Final Office Action at 12; See In re Kotzab, 217 F.3d at 1370, 55 U.S.P.Q.2d at 1317. Despite prior requests<sup>7</sup>, the Examiner has failed to supply any explanation of how Duesserre, Groh, and Kawashima are being applied, and

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<sup>7</sup> See Response to Final Office Action and Request to Withdraw its Finality at page 11 (Nov. 19, 2004).

she has not explained where Duesserre allegedly “teaches transferring human data via scanning,” as alleged in the Final Office Action. Pg.12.

Neither Rose nor La Rosa provides any suggestion or motivation to modify the other cited references in a manner that would suggest the claimed subject matter. As mentioned above, Rose relates to the non-analogous art of identifying insects and plants such as weeds. One of ordinary skill in the art would not look to such art to modify Herzog. Furthermore, nothing in La Rosa provides any suggestion of using Herzog’s scanner 16 to scan anything other than “additional documents, reports, graphics and/or films,” as described in Herzog at col. 3, lines 32-34.

Because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references in a manner that would result in the claimed invention, the § 103(a) rejection based on Herzog, Dusserre, Groh, and Kawashima should be reversed.

Dependent claims 3, 15-20, 21-23, 26-36, 39, 40, 43-45, 49-51 and 53-58 each depend from one of independent claims 1, 14, 25 and 38 and, therefore, include all the recitations of the corresponding independent claim from which they depend. As discussed above, each and every element is not disclosed or suggested, and there is no suggestion or motivation to combine Herzog, Dusserre, Groh, and Kawashima as proposed by the Examiner.

For at least these reasons, the § 103 claim rejection relying on Herzog, Dusserre, Groh, and Kawashima should be reversed.

5. **Rejection of claims 1, 3-10, 12, 14-16, 18, 38-43, 46-50 and 60-63 under 35 U.S.C. § 103(a) based on Rigg, Dusserre, Groh, and Kawashima should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness**

a. **Disclosure of Rigg**

Dusserre, Groh and Kawashima are discussed in detail above in sections VII. A(3), B(2) and B(4).<sup>8</sup> Rigg discloses a method and system for customizing skin foundation products. Rigg's method includes using a spectrophotometer/colorimeter that emits visible light and measures the wavelength of light reflected from the surface of skin to collect information used to formulate a cosmetic foundation product customized for the particular skin. Col. 5, lines 20-24.

b. **The rejection based on Rigg, Dusserre, Groh, and Kawashima does not set forth a *prima facie* case of obviousness because the references fail to disclose or suggest every element**

As previously discussed, the prior art references when combined must teach or suggest all the claim elements. See M.P.E.P. § 2143. None of Rigg, Dusserre, Groh, and Kawashima, either alone or in combination, discloses or suggests "scanning [a] transfer image with an optical image scanner," as recited in each of the rejected independent claims.

As discussed above in section VII B(4), Dusserre, Groh, and Kawashima, either alone or in combination, fail to disclose or suggest "scanning [a] transfer image with an optical image scanner," as recited in each of the rejected independent claims. Rigg does not correct this deficiency. The Examiner recognizes that Rigg's skin analyzer 2 is

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<sup>8</sup> To the extent that the rejection of claims 1, 3-10, 12, 14-16, 18, 38-43, 46-50, and 60-63 involves issues in common with those discussed in Sections VII.B(2) and B(4) (e.g., issues related to Dusserre, Groh, and/or Kawashima), Appellants corresponding remarks in those sections of the Brief are incorporated in this section of the Brief.

not an optical image scanner and that it is not used to scan a transfer image of a transfer member. Final Office Action at 15. Despite this acknowledged deficiency, the Examiner attempts to rely on Dusserre, but, as discussed above, Dusserre fails to provide any teaching or suggestion of scanning a transfer image of a transfer member. Thus, none of Rigg, Dusserre, Groh, and Kawashima, either alone or in combination, discloses or suggests “scanning [a] transfer image with an optical image scanner,” as recited in each of the rejected independent claims.

Additionally, Rigg, Dusserre, Groh, and Kawashima, either alone or in combination, fail to disclose or suggest “transfer member [that] is placed in contact with an external body portion including a cosmetic product applied thereto,” and an “image of the scanned image data [being] representative of at least one characteristic of the cosmetic product,” as recited in claims 4 and 47. Dusserre, Groh, and Kawashima are silent regarding cosmetic products.

Rigg specifically teaches taking wavelength readings of a “cleaned facial area,” and ensuring that the “customer’s face will be cleaned preparatory to a reading.” Col. 5, lines 18-20. Rigg does not have any teaching of anything being “placed in contact with an external body portion including a cosmetic product applied thereto” or “an image of the scanned image data [being] representative of at least one characteristic of the cosmetic product.” Thus, not only does Rigg fail to disclose or suggest the claimed method, but actually requires a step which would render impossible at least one feature of claims 4 and 47. Thus, none of Rigg, Dusserre, Groh, and Kawashima, either alone or in combination, discloses or suggests each and every element of claims 4 and 47.

Additionally, Rigg, Dusserre, Groh, and Kawashima do not provide any teaching or suggestion of “placing the adhesive material of the transfer member in contact with adhesive material of a second transfer member and separating the transfer members,” as recited in claim 3; “wherein the external portion includes lips” as recited in claim 5; “wherein the cosmetic product is one of a lip care product and a lip makeup product” as recited in claim 5; a “transfer member . . . formed of fabric” as recited in claim 7; a “transfer member [that] is an article of clothing,” as recited in claim 8; a “transfer member [that] is a sheet of material,” as recited in claim 9; “placing the sheet of material in contact with lips of the individual and transferring a lip product from the lips to the sheet of material,” as recited in claim 9; “wherein the lip product is lipstick,” as recited in claim 10; both scanning the transfer image and scanning the external portion, as recited in claim 14; or a “scanner for scanning documents,” as recited in claim 63. For each of these features, the Examiner either completely failed to address the claim limitations, or simply made an unsupported, conclusory allegation lacking any evidentiary support.

See Final Office Action at 15-16. The Final Office Action’s allegations simply do not provide a proper foundation for a *prima facie* case of obviousness.

Thus, at least for the reasons discussed above, the Examiner failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) because Rigg, Dusserre, Groh, and Kawashima, either alone or in combination, fail to disclose each claim feature.

- c. The rejection based on Rigg, Dusserre, Groh, and Kawashima does not set forth a *prima facie* case of obviousness because there is no motivation to combine the references

The Examiner did not establish any reasonable suggestion or motivation for one of ordinary skill in the art to have combined Rigg's skin foundation product customizing subject matter with the completely different subject matter disclosed in Dusserre, Groh, and Kawashima. At page 15 of the Final Office Action, the Examiner admits that Rigg lacks any teaching of an optical image scanner and placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image. Despite those acknowledged shortcomings, the Examiner cites Dusserre for the asserted teaching of telemedicine with optical imaging. The Examiner also cites Groh for the asserted teaching of scanning a transfer member with an adhesive. The Examiner, however, does not provide any legally sufficient suggestion or motivation establishing why one of ordinary skill in the art allegedly would have modified Rigg's foundation customizer to include such asserted subject matter.

For example, the Office Action fails to identify any sources supporting the allegations concerning "enhanced image quality" and a "more robust system." Final Office Action at 6. Since there is no suggestion or motivation for using Rigg's portable skin analyzer 2 to obtain an image, there is simply no legitimate reason for alleging that there would be a reason for modifying Rigg's subject matter for the alleged purpose of enhancing image quality. Furthermore, the hypothetical modifications apparently proposed in the Office Action appear to be directed to making a much more complicated arrangement, rather than increasing robustness.

In light of all of the differences between the subject matter of Rigg, Dusserre, Groh, and Kawashima, there simply is no reason why one of ordinary skill in the art would have made the modifications proposed in the Office Action.

Because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, the § 103(a) rejection based on Rigg, Dusserre, Groh, and Kawashima should be reversed.

Dependent claims 5-10, 15, 16, 18, 39-43, 47, 49-50 and 62 each depend from one of independent claims 1, 4, 14, 38, 46 and 61 and, therefore, include all the recitations of the respective independent claim from which they depend. As discussed above, each and every element is not disclosed or suggested, and there is no suggestion or motivation to combine Rigg, Dusserre, Groh, and Kawashima as proposed by the Examiner.

For at least these reasons, the § 103 claim rejection relying on Herzog, Dusserre, Groh, and Kawashima should be reversed.

**6. All rejections under 35 U.S.C. § 103 should be reversed because the Examiner applied improper hindsight reasoning**

The determination of obviousness must be done based on the knowledge possessed by one of ordinary skill in the art at the time when the invention was made. Thus, it is not permissible to use hindsight after viewing the claimed invention to determine questions of obviousness or to rely at all on the teachings of the claimed invention in determining whether one of ordinary skill in the art would find the invention obvious. See In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

Although the Final Office Action does not explicitly admit the claim rejections rely on hindsight, the Examiner emphasizes that the present specification discloses numerous transfer members and external areas, and also alleges that “they are considered equivalent since they perform the same function of obtaining scanned information.” Final Office Action at 6; see also *id.* at 15-16. This faulty reasoning seems to be the basis for all of the Examiner’s claim rejections.

By referring to examples described in the specification in an attempt to find features lacking in the prior art, the Examiner is clearly engaging in improper hindsight reasoning. Moreover, since the Examiner has not met the burden of establishing a *prima facie* case of obviousness, there is no need for the Applicants to demonstrate criticality for any subject matter.

Because the Examiner applied improper hindsight reasoning, the 35 U.S.C. § 103 rejections should be reversed.

### **C. Conclusion**

For the reasons given above, pending claims 1 and 3-63 are patentable over the cited references. The Board is therefore respectfully requested to reverse the outstanding rejections under 35 U.S.C. §§ 102 (“a and/or e”) and 103(a), so that claims 1 and 3-63 may be allowed.

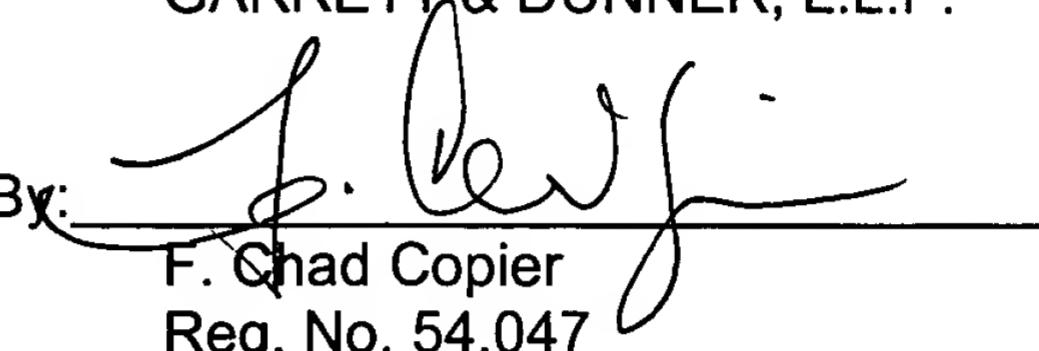
To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are

any fees due which are not enclosed herewith, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By:

  
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Dated: June 20, 2005

## **VIII. Claims Appendix**

1. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:
  - placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,
    - wherein the transfer member includes adhesive material provided on a backing, the adhesive material of the transfer member being placed in contact with skin while the adhesive material is on the backing and the transfer member being removed from the skin to transfer cells from the skin of the individual to the transfer member,
    - wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,
    - wherein the transfer image is not a fingerprint or fingerprints, and
    - wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and
  - scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or
  - at least one product applied to the external body portion.
3. The process of claim 1, further comprising placing the adhesive material of the transfer member in contact with adhesive material of a second transfer member and separating the transfer members to transfer a portion of the skin cells to the second transfer member.

4. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

    placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

    wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

    wherein the transfer image is not a fingerprint or fingerprints, and

    wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

    scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

        the external body portion, and/or

        at least one product applied to the external body portion,

    wherein the transfer member is placed in contact with an external body portion including a cosmetic product applied thereto, and wherein the image of the scanned image data is representative of at least one characteristic of the cosmetic product.

5. The process of claim 4, wherein the external portion includes lips and wherein the cosmetic product is one of a lip care product and a lip makeup product.

6. The process of claim 4, wherein the external portion includes skin and wherein the cosmetic product is foundation makeup.

7. The process of claim 6, wherein the transfer member is formed of fabric.

8. The process of claim 7, wherein the transfer member is an article of clothing.

9. The process of claim 4, wherein the transfer member is a sheet of material, and wherein the process includes placing the sheet of material in contact with lips of the individual and transferring a lip product from the lips to the sheet of material.

10. The process of claim 9, wherein the lip product is lipstick.

11. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising: placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion,

wherein the transfer member is a moldable material, and wherein the process includes placing the moldable material in contact with the skin of the individual to produce, on the moldable material, the surface profile of the skin.

12. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion,

wherein the transfer member is a window, the window being a portion of the image scanner defining a scanning region.

13. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer member is one of a hair comb and a hair brush, wherein the placing of the transfer member in contact with the external body portion includes passing said one of the hair comb and the hair brush through hair, and wherein the transfer image on the transfer member includes at least one of strands of hair and skin cells,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or  
at least one product applied to the external body portion.

14. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and  
wherein the external portion that the transfer member is placed in contact with  
does not include a tooth or teeth;  
scanning the transfer image with an optical image scanner to obtain scanned  
image data for an image representative of at least one characteristic of  
the external body portion, and/or  
at least one product applied to the external body portion;  
placing the external portion of the individual in the vicinity of a scanning region of  
the image scanner; and  
scanning the external portion with the image scanner.

15. The process of claim 14, wherein the scanning of the transfer image of the  
transfer member and the scanning of the external portion occur one of simultaneously  
and one after another.

16. The process of claim 14, wherein the external portion of the individual is  
placed into contact with the scanning region of the scanner.

17. The process of claim 16, wherein the scanner is a flat bed scanner and  
wherein the external portion of the individual is moved into contact with the scanning  
region.

18. The process of claim 16, wherein the scanner is a hand-held scanner and wherein the scanner is moved into contact with the external portion of the individual.

19. The process of claim 14, further comprising placing liquid between the external body portion and the scanning region, the liquid altering the index of refraction to improve visualization of said at least one characteristic.

20. The process of claim 14, further comprising placing at least one of a dye and a pigment on the external portion to improve visualization of said at least one characteristic.

21. The process of claim 1, wherein the external portion includes at least one of the skin of the individual, at least one strand of hair of the individual, at least one fingernail of the individual, and at least one toe nail of the individual.

22. The process of claim 21, wherein the external portion includes the skin of the individual, and wherein the external portion is located on one of the hand, foot, arm, leg, torso, and face of the individual.

23. The process of claim 22, wherein the external portion is located on the lips of the individual.

24. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the external portion includes at least one strand of hair of the individual,

wherein said at least one strand of hair is one of a strand of hair from the scalp of the individual, an eyelash of the individual, and an eyebrow hair of the individual,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion.

25. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and  
wherein the external portion that the transfer member is placed in contact with  
does not include a tooth or teeth; and  
scanning the transfer image with an optical image scanner to obtain scanned  
image data for an image representative of at least one characteristic of  
the external body portion, and/or  
at least one product applied to the external body portion,  
wherein the image scanner is associated with a first computer located at a first  
location, and wherein the process further comprises transferring the scanned image  
data from the first computer to a second computer located at a second location remote  
from the first location.

26. The process of claim 25, wherein the transferring includes transmitting the  
scanned image data via the Internet.

27. The process of claim 25, further comprising storing the scanned image data  
on a data storage medium, wherein the transferring includes shipping the data storage  
medium to the second location.

28. The process of claim 25, further comprising transferring questionnaire  
answers from the first location to the second location, at least some of the questionnaire  
answers being related to at least one of a condition of the external portion and the  
product applied to the external body portion.

29. The process of claim 25, further comprising sending to the second location at least one of billing information and payment information.

30. A process of analyzing at least one characteristic of an external body portion of an individual and/or at least one product applied to the external body portion, the process comprising:

acquiring scanned image data according to the process of claim 25;  
displaying an image corresponding to the scanned image data; and  
viewing the displayed image to analyze said at least one characteristic.

31. The process of claim 30, wherein the image is displayed at the second location.

32. The process of claim 30, further comprising sending the scanned image data to a plurality of locations so that the at least one characteristic may be analyzed numerous times.

33. The process of claim 30, further comprising monitoring status of the external portion during treatment of the external portion.

34. The process of claim 33, further comprising providing a recommendation for a treatment of the external portion based on the monitored status.

35. The process of claim 33, further comprising providing the individual with information regarding the effectiveness of the treatment.

36. The process of claim 33, wherein the monitoring includes repeating at least the acquiring.

37. A process of analyzing at least one characteristic of an external body portion of an individual and/or at least one product applied to the external body portion, the process comprising:

acquiring scanned image data, wherein the acquiring comprises

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth, and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion;

displaying an image corresponding to the scanned image data;

viewing the displayed image to analyze said at least one characteristic; and comparing the displayed image to at least one image formed from image data stored in an image database.

38. A process for recommending treatment for an external body portion, the process comprising:

analyzing at least one characteristic of an external body portion wherein the analyzing comprises

acquiring scanned image data, wherein the acquiring comprises  
placing a transfer member in contact with an external portion  
of an individual so as to obtain a transfer image on the transfer  
member,

wherein the transfer image is present on the transfer  
member after the transfer member and the external portion are out  
of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints,  
and

wherein the external portion that the transfer member is  
placed in contact with does not include a tooth or teeth;

scanning the transfer image with an optical image scanner to  
obtain scanned image data for an image representative of at least  
one characteristic of

the external body portion, and/or

at least one product applied to the external body portion; displaying an image corresponding to the scanned image data; and viewing the displayed image to analyze said at least one characteristic; determining a recommendation of at least one treatment for the external portion; and providing the treatment recommendation so that the external portion of the individual may be treated according to the recommendation.

39. The process of claim 38, wherein the treatment recommendation is a recommendation regarding use of at least one of a cosmetic product and a dermatological product.

40. The process of claim 39, wherein said at least one of the cosmetic product and the dermatological product is one of a makeup product, a care product, a hair product, a skin product, and a sun exposure product.

41. The process of claim 39, wherein the treatment recommendation is a recommendation regarding application of said at least one of the cosmetic product and the dermatological product to the external portion.

42. The process of claim 38, further comprising providing product ordering information along with the treatment recommendation.

43. The process of claim 38, wherein the providing of the treatment recommendation includes providing the treatment recommendation to at least one of the individual and a treatment provider.

44. The process of claim 43, wherein the providing of the treatment recommendation includes transmitting said recommendation to said at least one of the individual and the treatment provider via the Internet.

45. The process of claim 38, wherein a computer at least partially performs the determining of the treatment recommendation, the computer being located at a location remote from that of the image scanner.

46. A process of evaluating a product applied to an external body portion, the process comprising:

analyzing at least one characteristic of a product applied to an external body portion wherein the analyzing comprises

acquiring scanned image data, wherein the acquiring comprises  
placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,  
wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and  
wherein the external portion that the transfer member is placed in  
contact with does not include a tooth or teeth, and  
scanning the transfer image with an optical image scanner to obtain  
scanned image data for an image representative of at least one  
characteristic of  
the external body portion, and/or  
at least one product applied to the external body portion;  
displaying an image corresponding to the scanned image data; and  
viewing the displayed image to analyze said at least one  
characteristic.

47. The process of claim 46, wherein the transfer member is placed in contact  
with an external body portion including a cosmetic product applied thereto, and wherein  
the scanned image data is representative of at least one characteristic of the cosmetic  
product.

48. A process for acquiring scanned image data relating to an external body  
portion and/or a product applied to the external body portion, the process comprising:  
placing a transfer member in contact with an external portion of an individual so  
as to obtain a transfer image on the transfer member,  
wherein the transfer image is present on the transfer member after the transfer  
member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and  
wherein the external portion that the transfer member is placed in contact with  
does not include a tooth or teeth;  
scanning the transfer image with an optical image scanner to obtain scanned  
image data for an image representative of at least one characteristic of  
the external body portion, and/or  
at least one product applied to the external body portion; and  
collecting information relating to the transfer image of the transfer member to  
form a database for use in at least one of diagnoses, treatment recommendation  
determinations, product evaluations, and product formulations.

49. The process of claim 1, wherein the scanned image data includes data  
regarding color of said transfer image.

50. The process of claim 1, wherein the scanning includes emitting light from the  
scanner onto the transfer member.

51. The process of claim 1, wherein the scanner is configured in the form of a  
scanner for scanning documents.

52. A process for acquiring scanned image data relating to an external body  
portion and/or a product applied to the external body portion, the process comprising:

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,  
wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,  
wherein the transfer image is not a fingerprint or fingerprints, and  
wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and  
scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or  
at least one product applied to the external body portion,  
wherein the process further comprises scanning, with the image scanner, a calibration member having one of a predetermined size and a predetermined color.

53. The process of claim 1, wherein the process further comprises obtaining scanned image data relating to multiple scanned images.

54. The process of claim 1, wherein the transfer image on the transfer member indicates a condition of the external portion.

55. The process of claim 1, wherein the transfer member is configured to change color in response to a condition of the external portion.

56. The process of claim 1, further comprising treating at least one of the transfer member and the external body portion to enhance the transfer image on the transfer member.

57. The process of claim 1, wherein the process further comprises treating at least one of the transfer member and the external body portion, and removing the transfer member from the external body portion to transfer material to the transfer member, and wherein said treatment increases the amount of transferred material.

58. The process of claim 1, further comprising analyzing at least one of the external body portion and the transfer member with analysis equipment.

59. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:  
placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,  
wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,  
wherein the transfer image is not a fingerprint or fingerprints, and  
wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth;  
scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or  
at least one product applied to the external body portion; and  
analyzing at least one of the external body portion and the transfer member with  
analysis equipment,

wherein the analysis equipment is chosen from one of a corneometer, a dermal  
torque meter, an image analyzer, a PH meter, and a device for measuring hydration of  
the skin.

60. The process of claim 1, further comprising analyzing the external portion,  
wherein the analyzing of the external portion is performed by a trained person.

61. A process for acquiring scanned image data relating to an external body  
portion and/or a product applied to the external body portion, the process comprising:  
placing a transfer member in contact with an external portion of an individual so  
as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer  
member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with  
does not include a tooth or teeth;

scanning the transfer image with an optical image scanner to obtain scanned  
image data for an image representative of at least one characteristic of  
the external body portion, and/or

at least one product applied to the external body portion; and  
providing a grade indicative of at least one of the condition of the external portion  
and performance of the product.

62. The process of claim 61, further comprising storing information relating to the  
grade in a database.

63. A process for acquiring scanned image data relating to an external body  
portion and/or a product applied to the external body portion, the process comprising:  
placing a transfer member in contact with an external portion of an individual so  
as to obtain a transfer image on the transfer member,  
wherein the transfer image is present on the transfer member after the transfer  
member and the external portion are out of contact with one another, and  
wherein the transfer image is not a fingerprint or fingerprints; and  
scanning the transfer image with an optical image scanner to obtain scanned  
image data for an image representative of at least one characteristic of  
the external body portion, and/or  
at least one product applied to the external body portion,  
wherein the scanner is configured in the form of a scanner for scanning  
documents.

**IX. Evidence Appendix**

**None**

**X. Related Proceedings Appendix**

None



PATENT  
Customer No. 22,852  
Attorney Docket No. 05725.0800

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
Roland BAZIN et al. ) Group Art Unit: 3743  
Application No.: 09/725,048 ) Examiner: Kathryn P. ODLAND  
Filed: November 29, 2000 ) Confirmation No.: 8605  
For: PROCESS FOR ACQUIRING )  
SCANNED IMAGE DATA )  
RELATING TO AN EXTERNAL )  
BODY PORTION AND/OR A )  
PRODUCT APPLIED THERETO )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PETITION FOR EXTENSION OF TIME**

Applicants petition for a three-month extension of time to file an Appeal Brief after the Notice of Appeal filed January 28, 2005. A fee payment of \$1,020.00 is enclosed.

Please grant any extensions of time required to enter the Appeal Brief and charge any additional required fees to our Deposit Account No. 06-0916.

06/21/2005 SZEWDIE1 00000008 09725048

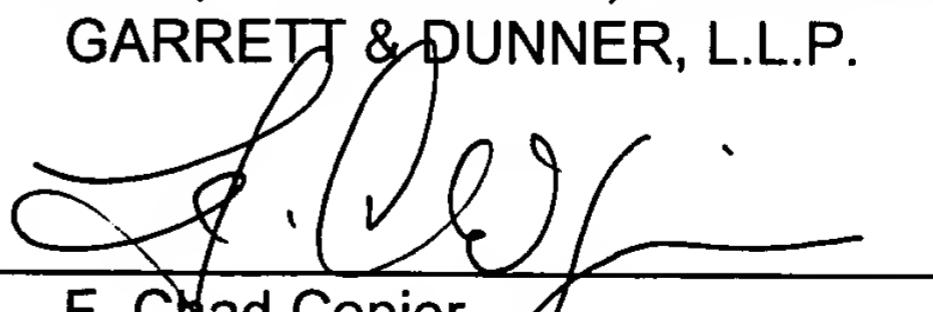
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1020.00 0P

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:

  
F. Chad Copier  
Reg. No. 54,047

Dated: June 20, 2005



PATENT  
Customer No. 22,852  
Attorney Docket No. 05725.0800

## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: )  
Roland BAZIN et al. ) Group Art Unit: 3743  
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BODY PORTION AND/OR A )  
PRODUCT APPLIED THERETO )

### Mail Stop Appeal Brief--Patents

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

### TRANSMITTAL OF APPEAL BRIEF (37 C.F.R. 41.37)

Transmitted herewith is the APPEAL BRIEF in this application with respect to the  
Notice of Appeal filed on January 28, 2005.

This application is on behalf of

Small Entity       Large Entity

Pursuant to 37 C.F.R. 41.20(b)(2), the fee for filing the Appeal Brief is:

\$250.00 (Small Entity)  
 \$500.00 (Large Entity)

**TOTAL FEE DUE:**

Notice of Appeal Fee      \$ 500.00

Extension Fee (if any)      \$1020.00

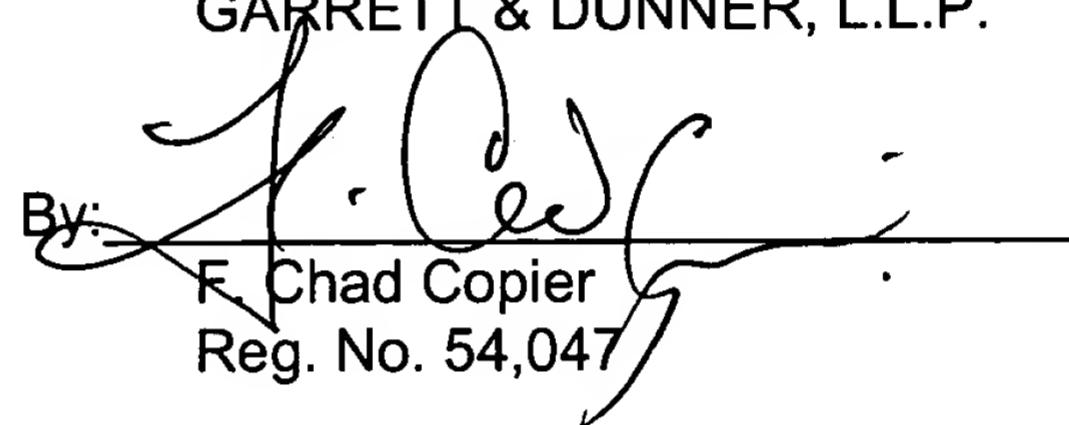
Total Fee Due \$1520.00

Enclosed are two checks for \$1020.00 and \$500.00 to cover the above fees.

PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this Appeal Brief, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to our Deposit Account No. 06-0916. A duplicate copy of this paper is enclosed for use in charging the deposit account.

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 20, 2005

By:   
F. Chad Copier  
Reg. No. 54,047